UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,904	04/10/2001	Sunil H. Contractor	BS00-363	7194

28970	7590	03/29/2006

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EXAMINER
PHAM, THOMAS K

ART UNIT	PAPER NUMBER
2121	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/828,904	CONTRACTOR, SUNIL H.
	Examiner	Art Unit	
	Thomas K. Pham	2121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 February 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-24,26-51 and 53-55</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-24,26-51 and 53-55</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892).

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948).

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)　　　　　　　　Office Action Summary　　　　　　Part of Paper No./Mail Date 20060321

Response to Amendment

1.   This action is in response to the after final request for reconsideration filed on 02/10/2006.

2.   Applicant's arguments in the request for reconsideration of the finality of the rejection of the last Office action is not persuasive. However, to provide a better support for the last rejection, new grounds of rejection presented in this Office action, and, therefore, the finality of that action is withdrawn.

Quotations of U.S. Code Title 35

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim Rejections - 35 USC § 101

5.   The language of the claim raises a question as to whether the claim is directed merely to

an abstract idea that is not tied to a technological art, environment or machine which would

result in a practical application producing a concrete, useful, and tangible result to form the basis

of statutory subject matter under 35 U.S.C. 101.

Claim 45 is rejected under 35 U.S.C. 101 as directed to non-statutory subject matter. The

claimed invention is nothing more than an abstract idea that is not a practical application

producing a useful and tangible result as explain below:

- applicant's disclosure seems to have a utility required for a practical application,

   however, the claim does not reflect the disclosure. Thus, the claimed invention as a whole

   lacks patentable utility that required for a practical application producing useful result.

   For example, the system of the claimed invention is performing a variety of operational

   functions without producing any useful result.

- in addition, the claimed invention do not provide a tangible or real-world result. A

   tangible requirement required that the claim must recite more than a Sec. 101 judicial

   exception, in that the process claim must set forth a practical application of that Sec. 101

   judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ

   at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n

   application of a law of nature or mathematical formula to a . . . process may well be

   deserving of patent protection." Diehr, 450 U.S. at 187, 209 USPQ at 8 (emphasis added);

   see also Corning, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or

   invention of some practical method or means of producing a beneficial result or effect,

that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

Claim 46 is rejected under 35 U.S.C. 101 as non-statutory for at least the reason that it is not producing a tangible result. Claim 46 is depended on claim 45, however, it does not add any feature or subject matter that represent any real-world result.

Claim 47 is rejected under 35 U.S.C. 101 as directed to non-statutory for at least the reason that it is not producing a tangible result. Claim 47 is depended on claim 46, however, it does not add any feature or subject matter that represent any real-world result.

Claim 48 is rejected under 35 U.S.C. 101 as non-statutory for at least the reason that it is not producing a tangible result. Claim 48 is depended on claim 45, however, it does not add any feature or subject matter that represent any real-world result.

Claim 49 is rejected under 35 U.S.C. 101 as directed to non-statutory for at least the reason that it is not producing a tangible result. Claim 49 is depended on claim 46, however, it does not add any feature or subject matter that represent any real-world result.

Claim 50 is rejected under 35 U.S.C. 101 as directed to non-statutory for at least the reason that it is not producing a tangible result. Claim 50 is depended on claim 47, however, it does not add any feature or subject matter that represent any real-world result.

Claim Rejections - 35 USC § 103

6.   Claims 1-6, 9-17, 30-36, 38-44, 51 and 53-55 are rejected under 35 U.S.C. 103(a) as

being unpatentable over U.S. Patent No. 5,870,724 ("Lawlor") in view of U.S. Patent

Application Publication No. 2004/0236650 ("Zapiec").

Regarding claim 1

Lawlor teaches a method for contacting a user, comprising:

- electronically receiving online session data that specifies users immediately in real-time

     (col. 31 lines 48-56);

- processing on a computer processor ("central computer 52") the online session data to

     identify users to call (col. 31 lines 48-52) who have recently ended their online sessions

     (col. 31 lines 57-59, "... as soon as the user disconnects his terminal ..."); and

- calling the users who have recently ended their online sessions (col. 31 lines 57-59, "The

     advertiser may then call the user as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether the advertiser electronically receive the online

session data that specifies users who have ended recent online sessions.

However, Zapiec discloses a software means for collecting and electronically

transmitting FTP file in real-time information regarding an Internet online session of a user such

as from the time the user logs on to the online session to the time the user logs off the online

session (see paragraph 41) for the purpose of recording all Internet activity and corresponding

usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the software means of Zapiec with the system of Lawlor because it

would provide Lawlor with an additional benefit of recording and transmitting in real-time to the advertiser information regarding online activities and the corresponding usage times of a particular user including at least when the user logs off the online sessions.

Regarding claim 30.

Lawlor teaches a system for contacting a user, comprising:

- means for receiving online session data that specifies users immediately in real-time (col. 31 lines 48-56);

- means for processing the online session data to identify users to call (col. 31 lines 48-52) who have recently ended their online sessions (col. 31 lines 57-59, "... as soon as the user disconnects his terminal ..."); and

- means for calling the users who have recently ended their online sessions (col. 31 lines 57-59, "The advertiser may then call the user as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether the advertiser receives the online session data that specifies users who have ended recent online sessions.

However, Zapiec discloses a software means for collecting and electronically transmitting FTP file in real-time information regarding an Internet online session of a user such as from the time the user logs on to the online session to the time the user logs off the online session (see paragraph 41) for the purpose of recording all Internet activity and corresponding usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software means of Zapiec with the system of Lawlor because it

would provide Lawlor with an additional benefit of recording and transmitting in real-time to the advertiser information regarding online activities and the corresponding usage times of a particular user including at least when the user logs off the online sessions.

Regarding claim 10

Lawlor teaches a method of identifying users to a caller, comprising:

- transmitting a user information record to a caller to cause the caller to place a call to the user after the online session has ended (col. 31 lines 53-59, "... user information is to pass it to the advertiser ... as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether the end of an online session of a user is detected; and storing a record of the online session that indicates that the online session of the user has recently ended.

However, Zapiec discloses a software means for collecting and electronically transmitting FTP file in real-time information regarding an Internet online session of a user such as from the time the user logs on to the online session to the time the user logs off online session (see paragraph 41); and storing a record of the online session that indicates activities of the users including when the user has just logged off the online Internet sessions (see paragraphs 14 and 66) for the purpose of recording all Internet activity and corresponding usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software means of Zapiec with the system of Lawlor because it would provide Lawlor with an additional benefit of recording and transmitting in real-time to the

advertiser information regarding online activities and the corresponding usage times of a particular user including at least when the user logs off the online sessions.

Regarding claim 40

Lawlor teaches a system for dentifying users to a caller, comprising:

- means for transmitting the record to a caller to cause the caller to place a call to the user after the online session has ended (col. 31 lines 53-59, "... user information is to pass it to the advertiser ... as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether the end of an online session of a user is detected; and storing a record of the online session that indicates that the online session of the user has recently ended.

However, Zapiec discloses a software means for collecting and electronically transmitting FTP file in real-time information regarding an Internet online session of a user such as from the time the user logs on to the online session to the time the user logs off the online session (see paragraph 41); and storing a record of the online session that indicates activities of the users including when the user has just logged off the online Internet sessions (see paragraphs 14 and 66) for the purpose of recording all Internet activity and corresponding usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software means of Zapiec with the system of Lawlor because it would provide Lawlor with an additional benefit of recording and transmitting in real-time to the advertiser information regarding online activities and the corresponding usage times of a particular user including at least when the user logs off the online sessions.

Regarding claim 51

Lawlor teaches a system for identifying users to call, comprising:

- an output module for sending the online session data to a third party caller to cause the third party to place a call to the user after the online session of the user has ended(col. 31 lines 53-59, "... user information is to pass it to the advertiser ... as soon as the user disconnects his terminal ...").

Lawlor does not specifically disclose whether a remote access server for determining when an online session of a user has ended; and a memory for storing online session data including data sufficient to identify the time the online session of a user ended.

However, Zapiec discloses a remote access server (see paragraph 37) with a software means for collecting and electronically transmitting FTP file in real-time information regarding an Internet online session of a user such as from the time the user logs on to the online session to the time the user logs off the online session (see paragraph 41); and a memory for storing a record of the online session that indicates activities of the users including when the user has just logged off the online Internet sessions (see paragraphs 14 and 66) for the purpose of recording all Internet activity and corresponding usage times (see paragraph 13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the software means of Zapiec with the system of Lawlor because it would provide Lawlor with an additional benefit of recording and transmitting in real-time to the advertiser information regarding online activities and the corresponding usage times of a particular user including at least when the user logs off the online sessions

Regarding claim 2

Lawlor teaches the online session data identifies a user that has completed an Internet session.
(col. 31 lines 52-59).

Regarding claims 3, 15, 38 and 53

Lawlor teaches the online session data includes a phone number (col. 3 lines 51).

Regarding claims 4, 16 and 55

Lawlor teaches the online session data includes a phone number and an address (col. 32 lines 5-
12).

Regarding claims 5, 6, 17 and 36

Zapiec teaches a determination of the time and the time interval since an Internet session was
completed (see paragraph 66).

Regarding claims 9, 11, 12 and 44

Lawlor teaches a third party other than the ISP and other than the user receives the session data
(col. 31 lines 48-52); the third party is a telemarketer (col. 31 line 54).

Regarding claim 13

Lawlor teaches transmitting is performed in substantially real time relative to the step of storing
(col. 31 lines 52-55).

Regarding claim 14

Lawlor teaches the transmitting is performed in real-time (col. 31 lines 52-55, it should be noted
that real-time must be within fifteen minutes).

Regarding claim 42

Lawlor teaches the online session data includes a phone number and the end time of an online

session (col. 31 lines 48-57).

Regarding claim 39

Lawlor does not teach the step of repeating phone calls to users is automated. "Official Notice"

is take for the concept and advantage of automatically redial/dial phone calls is well known and

expected in the art. U.S. Patent 6,438,599 discloses the telephone initiator can be done

automatically by a computer software (see col. 5 lines 42-45).

Regarding claim 31

Lawlor teaches the means for receiving online session data comprises means for communicating

with an Internet Service Provider (ISP) (col. 31 lines 48-52).

Regarding claims 32, 33, 34, 35 and 43

Zapiec teaches transmitting the online session data in form of a FTP file (see paragraph 41).

Regarding claim 41

Lawlor teaches detecting comprises a remote access server (col. 31 lines 52-59).

Regarding claim 54

Lawlor teaches the online session data includes a name (col. 31 line 51).

7. .   Claims 7-8, 18-24, 26-29, 37 and 45-50 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Lawlor in view of Zapiec and further in view of U.S. Patent 6,272,126

("Strauss").

Regarding claims 18 and 45

Lawlor teaches contacting users, comprising: placing calls to users based on online session data that specifies users who recently ended an online session (col. 31 lines 48-59, "... central computer 52 may then provide limited user information ... immediately in real-time ... as soon as the user disconnects his terminal ...").

Lawlor and Zapiec do not teach storing call details for calls not successfully completed; comparing the call details to online session data; and repeating phone calls to users that were previously unsuccessfully called based on the step of comparing.

However, Strauss teaches storing call details for calls not successfully completed (abstract, "... In according with the invention, monitor equipment ... into a relational database ... "); detecting any busy or failed calls to ISP for translation (comparison) in order to notify the originating called party (col. 10 lines 3-15, *It should be noted that the ISP must compare the fail calls data with the online data in order to get the contact information of the called party.*); and repeating phone calls to users that were previously unsuccessfully called based on the step of comparing (col. 12 lines 52-54) for the purpose of providing simple and convenient dialing to users (see col. 5 lines 1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the calls handing method of Strauss with the targeting advertising system of Lawlor because it would provide for the purpose of providing simple and convenient dialing to users.

Regarding claims 7 and 37

Lawlor and Zapiec do not specifically disclose generating one or more data related to failed calls to users; and comparing the session data to one or more data related to failed calls to users.

However, Strauss teaches upon detecting a busy signal or failed call, the system generates

a datagram busy signal or failed call for sending to the original ISP for translation (comparison)

and deliver to the originating called party (col. 10 lines 3-15, *It should be noted that the ISP must

compare the fail calls data with the online data in order to get the contact information of the

called party.*) for the purpose of providing simple and convenient dialing to users (see col. 5 lines

1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate the calls handing method of Strauss with the targeting advertising

system of Lawlor because it would provide for the purpose of providing simple and convenient

dialing to users.

Regarding claims 8, 20 and 23

Strauss teaches the failed calls comprise one or more of busy calls and unanswered calls (col. 12

lines 63-66, "If the called party fails ... to its ISP Server 416").

Regarding claim 19

Lawlor teaches the online session data includes a phone number (col. 31 line 51).

Regarding claim 21

Strauss teaches receiving the call details from a telephone service provider (col. 8 lines 7-14,

"the PC Server A is ... of the calling party").

Regarding claim 22

Strauss teaches the telephone service provider stores the call details based on a trigger at a

Service Switching Point (SSP) (col. 8 lines 35-45, "Each customer of the ... carrier network in

New Orleans").

Regarding claim 24

Strauss teaches the online session data is provided by an Internet Service Provider (ISP) (col. 7

lines 1-7, "The local ISP is ... the destination service provider").

Regarding claims 26 and 48

Lawlor teaches the online session data includes a phone number and the end time of an online

session (col. 31 lines 48-57).

Regarding claims 27 and 46

Strauss teaches comparing phone numbers in the call details to phone numbers in the online

session data (col. 10 lines 3-15).

Regarding claim 29

Lawlor and Strauss do not teach the step of repeating phone calls to users is automated. "Official

Notice" is take for the concept and advantage of automatically redial/dial phone calls is well

known and expected in the art. U.S. Patent 6,438,599 discloses the telephone initiator can be

done automatically by a computer software (see col. 5 lines 42-45).

Regarding claim 47

Lawlor teaches a determination of the time and the time interval since an Internet session was

completed (col. 31 lines 52-59).

Regarding claim 49

Strauss teaches the call details include whether a call was busy or unanswered (col. 12 lines 63-

66, "If the called party fails ... to its ISP Server 416").

Regarding claim 50

Lawlor, Zapiec and Strauss do not teach comparing the time interval to a threshold to determine

whether a specific user is targeted for a repeat call. "Official Notice" is take for the concept and

advantage of the time interval in automatically redial/dial phone calls is well known and expected in the art. U.S. Patent 6,438,599 discloses the telephone initiator can be done automatically by a computer software (see col. 5 lines 42-45).

Response to Arguments

In the remark the applicant argues that cited reference fails to disclose:

I) "receiving online session data that specifies users who have ended recent online sessions" as to all the independent claims.

In response to applicant's argument,

I)   Prior art Zapiec (US Patent Application Publication No. 2004/0236650) a software means for recording for specific users all information regarding online Internet sessions activity in "real-time" from the time the users log on to the Internet to the time the users log off the online sessions. The information is then transmit electronically with in a FTP file to a remote cite for usage such as billing and/or tracking the user's time spent on an Internet session as described in paragraphs 41 and 66.

Therefore, by incorporating the software means of Zapiec with the system of Lawlor, the system of Lawlor would now include an additional benefit for recording and transmitting to an advertiser, in **real-time,** information regarding a user's online activities and the corresponding usage times including at least the exact time when the user logged off the online sessions. Since information transmitted in real-time, the advertiser may then call the user as soon as he receives a user's record indicates that the user has recently logged off online sessions which may have free up his telephone line as described in Lawlor column 31 lines 52-59.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thomas Pham*; whose telephone number is (571) 272-3689, Monday - Thursday from 6:30 AM - 5:00 PM EST or contact Supervisor *Mr. Anthony Knight* at (571) 272-3687.

Any response to this office action should be mailed to: **Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450.** Responses may also be faxed to the **official fax number (571) 273-8300.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas Pham
Patent Examiner

March 22, 2006

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